

DOCKET NO: 201930US25X CONT



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :

DAVID W. DEATON, ET AL. :

EXAMINER: GRAVINI, S.

SERIAL NO: 08/935,116 :

CPA FILED: AUGUST 28, 2001 :

GROUP ART UNIT: 3622

FOR: SYSTEM, METHOD AND
DATABASE FOR PROCESSING
TRANSACTIONS :

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SUPPLEMENTAL REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This reply brief is filed in response to new issues raised in the Supplemental Examiner's Answer mailed May 19, 2003.

I.

In response to paragraph (7) on the first page 2¹ of the Supplemental Examiner's Answer, appellants note that claims 8-39 do not stand or fall together. In section VIII of the appeal brief, appellants have indicated with respect to each rejection whether the claims stand or fall together. To the extent that appellants have argued that claims do not stand or fall together because the added limitation(s) in the respective dependent claims are not disclosed

Please note that the Supplemental Examiner's Answer has two pages numbered 2. Page 3 starts a new numbering sequence beginning with the number 1. Hereafter, page citations will be to the new numbering sequence.

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or suggested by the cited references, the burden is on the examiner to show otherwise. In re Lee, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002).

II.

The Examiner no longer relies on U.S. Patent No. 5,659,469. The Examiner relied on that reference in the final rejection as the basis for an obviousness-type double patenting rejection of claims 15 and 16. That rejection has been dropped in the Supplemental Examiner's Answer. In addition, the obviousness-type double patenting rejection of claims 33-39 over claims 1-3 of U. S. Patent No. 5,592,560 has been dropped in the Supplemental Examiner's Answer.

III.

With respect to the rejection of claims 8, 9, 12, and 13 as being anticipated under 35 USC 102(b) by Creekmore, the examiner states on page 9 lines 2-10 of the Supplemental Examiner's Answer that:

Appellants state that the examiner is incorrect because a distinction is not made between the terminal for entering unique customer identification codes for customer information and means for allowing entry of customer transaction data. A distinction need not be made because, beginning at the first full paragraph of column 6, "input terminal 13 transmits customer-entered information, as well as machine-readable information obtained from the identification card 15, to the transaction processor 19." Examiner interprets this recitation, as read in the contents of Creekmore, to anticipate Appellants first two clauses (a terminal for entering and means for allowing) of claim 8.

In response, appellants submit that, contrary to the examiner's contention, terminal 13 of Creekmore is used for entering unique customer identification information from the customer presented at the terminal 13 (identification card 15 and pin number). In contrast, no

transaction data is entered at terminal 13 of Creekmore (column 3 lines 32-33 and column 5 lines 37-45).

IV.

With respect to the rejection of claims 33-39 as being anticipated under 35 USC 102(b) by Goldman et al., the examiner states on page 9 line 19-page 10 line 4 of the Supplemental Examiner's Answer with reference to column 5 of Goldman et al. that: "A worthless check has a zero dollar amount which implicitly anticipates Appellants claimed transaction data including dollar amount. It is also implied in column 1, that merchants will cash checks after requesting a form of identification. The check cashing implicitly will carry a dollar amount since customers use checks for merchant purchases based on a dollar amount of goods and/or services. The same table at column 5 discloses the number of checks cashed during a current period. This current period disclosure anticipates Appellants claimed transaction data including time period."

In response, appellants submit that the table in column 5 of Goldman et al. fails to support the examiner's assertions the claimed limitations are implicitly disclosed therein. In fact, there is no disclosure in that table of a customer's prior transactions stored in association with a customer's transaction data including "dollar amount of purchases and time period" as recited in claim 33 or "total dollar amount of purchases purchased during a period of time associated with an identification of a customer" as recited in claim 34. In addition, there is no support for the examiner's assertions that the subject matter in dependent claims 35-39 is anticipated by Goldman et al.

V.

With respect to the rejection of claims 10, 11, and 14 under 35 USC 103(a) as being obvious over Creekmore in view of Off et al. and Tai, the examiner has quoted from column

3 of Tai on pages 14-15 of the Supplemental Examiner's Answer. However, that quotation fails to make up for the deficiencies in Creekmore and Off et al. noted in appellants brief on page 23. The disclosure in Tai relied upon by the examiner at most teaches that, if a prospective customer returns an encoded coupon, the retail establishment merely refines its mailing list. Tai does not teach or suggest generating a customer information response at the point-of-sale during the individual customer's transaction in the retail establishment upon detection of a unique identification code of the customer as set forth in claims 10, 11, and 14.

V.

With respect to the rejection of claims 17-32 under 35 USC 103(a) over Creekmore in view of Off et al., Tai, and Bigari, the examiner quotes from Bigari on page 19 of the Supplemental Examiner's Answer. However, the portion quoted from Bigari merely relates to the concept of pre-approving a maximum charge amount for a customer and requiring the customer to remove items from his or her shopping basket at the checkout counter if the cost of the items in the shopping basket exceeds the pre-approved maximum charge amount. That disclosure does not make up for the deficiencies in Creekmore, Off et al., and Tai with respect to the subject matter recited in claims 17-32. In particular, the Bigari disclosure does not teach or suggest (1) "a database storing transaction data from prior transactions for a plurality of customers, such that data regarding a customer's prior transactions are stored in association with identification of that customer" or (2) that "said customer information response signal depends upon data stored in said database indicating dollar amount of at least one prior purchase associated with said unique customer identification" as set forth in claim 17. The disclosure in Bigari relied upon by the examiner relates to activities that occur during the current shopping transaction. Independent claims 22, 27, and 30 also distinguish over the disclosure in Bigari for the reasons noted above with respect to claim 17.

VII.

With respect to the rejection of claims 33-39 under 35 USC 101, the examiner states on page 21 of the Supplemental Examiner's Answer that "Appellants have not argued that the amended claims clearly recite a useful, concrete, and tangible result." Contrary to this assertion by the examiner, appellants did argue on page 33 of the appeal brief that claims 33-39 provide a useful, concrete, and tangible result.

VIII.

With respect to the rejection of claims 8, 9, 12, and 13 on the ground of obviousness-type double patenting, the examiner states on page 22 lines 8-14 of the Supplemental Examiner's Answer that "The application claimed 'unique customer identification codes' is equivalent to the patented claim 'customer's unique customer identification codes' limitation. The second claimed feature, 'means for allowing entry of customer transaction data' is equivalent to the patented claim 'a terminal for entering unique customer identification codes from customer identification presented at the point of sale in a retail transaction' because customer identification code[s] are part of customer transaction data in both the application and the patent."

In response, appellants point out that the system disclosed in claim 23 of the '196 patent does not include (1) the "means for allowing entry of customer transaction data" or (2) or "a processor and a memory responsive to said terminal and to said means for allowing entry for creating a database for a plurality of the retail establishment's customers' transaction data from prior shopping visits...." The database recited in claim 23 of the '196 patent is used for entering a customer's unique customer identification code so that the customer's identification code can be compared with a database to provide an up-to-date list of the stores customers. Claim 23 of the '196 patent further provides structure for comparing a list of the store's prospective customers with a list of the store's existing customers and to

eliminate data with respect to the store's existing customers to thereby produce a non-customer database. Thus, the structure recited in claim 23 of the '196 patent does not teach or suggest either the "means for allowing entry of customer transaction data" or "a processor and a memory responsive to said terminal and said means for allowing entry for creating a database for a plurality of the retail establishment's customers" transaction data from prior shopping visits" as set forth in claim 8. Likewise, claim 23 of the '196 patent does not teach or suggest the corresponding limitations in claim 9.

IX.

With respect to the rejection of claims 10, 11, and 14 on the ground of obviousness-type double patenting over claims 18 and 26 of the '010 patent in view of Tai, the examiner's discussion of Tai on page 24 of the Supplemental Examiner's Answer at most indicates that the Tai disclosure is directed to a process for revising a mailing list. It does not teach or suggest "generating a customer information response at the point-of-sale during said individual customer's transaction in said retail establishment upon detection of a unique identification code of said individual customer, said response signal being related to said individual customer's transaction data in shopping visits prior to the current shopping visit" as set in forth in claim 10. Accordingly, Tai fails to make up for the deficiencies in claims 18 and 26 of the '010 patent with respect to the subject matter in claim 10 or the corresponding subject matter in independent claim 11.

X.

Appellants note that the examiner now relies at page 9 of the Supplemental Examiner's Answer on claims 1 and 3 of U.S. patent No. 5,592,560 rather than U.S. Patent No. 5,529,560 as the basis for the rejection of claims 17-32 on the ground of obviousness-type double patenting. The 5,529,560 patent was cited in the final rejection and in the

Examiner's Answer at page 10 line 5 as the basis for the rejection. Nevertheless, appellants have assumed that the examiner intended to rely on the 5,592,560 patent, and they have so treated the rejection. For the reasons stated in their main brief, appellants submit that claims 17-32 are patentably distinct from claims 1 and 3 of U.S. patent No. 5,592,560.

Respectfully submitted,



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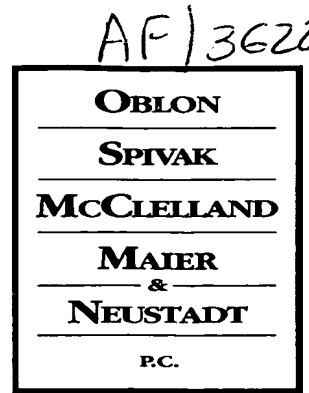
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ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

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Applicants: David W. DEATON, et al.
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Group Art Unit: 3622
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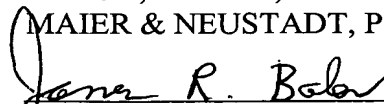
Attached hereto for filing are the following papers:

Supplemental Reply Brief (in triplicate)

Our check in the amount of 0.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

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